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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

920476-904776

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on October 28, 2005Signature Minnie WilsonTyped or printed name Minnie Wilson

Application Number

09/849,927

Filed

05-04-2001

First Named Inventor

John E. Hudson

Art Unit

2634

Examiner

Sudhanshu C. Pathak

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 26,935☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

SignatureWilliam M. Lee, Jr.
Typed or printed name312-214-4800

Telephone number

October 28, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of : John E Hudson
Serial No. : 09/849,927
Filed : May 4, 2001
For : Equaliser For Digital Communications
 Systems And Method of Equalisation
Examiner : Sudhanshu C. Pathak
Art Unit : 2634
Customer number : 23644

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450," on October 28, 2005.
 Name of person signing Minnie Wilson
 Signature Minnie Wilson
 Minnie Wilson

SUCCINCT STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Director of Patents and Trademarks
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

As required under the Pilot Program initiated July 12, 2005, following is the Applicant's statement in support of the Appeal Brief Conference for this application:

The Examiner's primary rejection is under 35 U.S.C. §103 as being unpatentable over the Applicant admitted prior art in view of DiToro U.S. Patent No. 4,058,713. The improper combination of these references has been addressed at length during the prosecution of this application.

This is a clear cut example of arbitrary and impermissible hindsight reasoning. The Examiner has jumped straight from the allegations of features disclosed in two items of prior art (AAPA and DiToro) to "Therefore, it would have been obvious" without any intermediate argument. In particular, the Examiner has failed to address

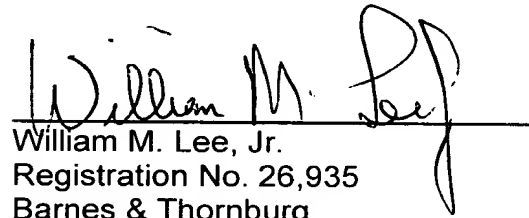
why one skilled in the art would combine the teachings. As a matter of law, the Examiner needs to show 1) that the prior art teaches each and every feature of the claimed invention; 2) motivation to combine the prior art teachings and; 3) a reasonable expectation of success else he has failed to establish a prima facie case of obviousness. The Examiner has failed to show at least 2) and 3).

Appellant contends that one skilled in the art would not seriously consider combining the teachings for at least the following reasons: 1) INCOMPATIBILITY: the STTD system of AAPA is designed for mitigation of non-dispersive channel effects whereas DiToro is a dispersive system, therefore one skilled in the art would not be motivated to combine the teachings and would have absolutely no expectation of success; 2) DiToro specifically requires that time gaps be inserted to ensure that message frames and test signals do NOT overlap in time, whereas in contrast it is inherent in the claimed invention that dispersion would result in overlapping of message frames and test signals, therefore DiToro TEACHES AWAY from the invention and one skilled in the art would not be motivated to combine DiToro with any other prior art since that would not lead to the present invention; and 3) the fact that the AAPA teachings date to 1998, whereas the DiToro reference is a very old reference dated 1977 (a difference of some 11 years), itself suggest that it would not be obvious for one skilled in the art to combine the references as suggested by the Examiner.

It is therefore submitted that the Examiner's rejections of the claims of this application are untenable as has been consistently argued by the Applicant, and were this application to proceed to the Board of Appeals and Interferences, the Examiner would clearly be reversed. The results of this review are therefore awaited.

October 28, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William M. Lee, Jr.", is written over a horizontal line.

William M. Lee, Jr.
Registration No. 26,935
Barnes & Thornburg
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 214-4800
(312) 759-5646 (fax)